Supreme Court, U. S.
FILED
NOV 10 1977
MICHAEL RODAK, JR., CLERK

No. 77-203

In the Supreme Court of the United States

OCTOBER TERM, 1977

EDWARD S. IRONS, PETITIONER

v.

LUTRELLE F. PARKER, ACTING COMMISSIONER OF PATENTS AND TRADEMARKS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

WADE H. MCCREE, JR.,
Solicitor General,
Department of Justice,
Washington, D.C. 20530.

In the Supreme Court of the United States

OCTOBER TERM, 1977

No. 77-203

EDWARD S. IRONS, PETITIONER

v.

LUTRELLE F. PARKER, ACTING COMMISSIONER OF PATENTS AND TRADEMARKS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

MEMORANDUM FOR THE RESPONDENT IN OPPOSITION

Petitioner brought this action pursuant to the Freedom of Information Act, 5 U.S.C. 552, to compel disclosure of " 'all unpublished decisions of the Patent Office' and existing indices thereto" (Pet. 6).[1] The district court awarded

---

[1]This case has been before the court of appeals three times, and before this Court twice. In 1972, this Court denied petitioner's petition for certiorari, 409 U.S. 1076, from the court of appeals' initial decision in this case, 465 F. 2d 608 (C.A. D.C.), which affirmed the district court's dismissal of the complaint insofar as it requested all unpublished manuscript decisions, but remanded for further consideration regarding the request for indices. In 1974, petitioner sought summary reversal of a decision of the district court on the ground that the district judge had engaged in improper *ex parte* contact with representatives of the respondent. The court of appeals denied petitioner's motion for summary reversal, and this Court denied certiorari. 420 U.S. 946.

disclosure only of certain indices (Pet. App. B). The court of appeals, in a decision that was substantially favorable to petitioner, reversed in part and remanded (Pet. App. A). The court agreed with petitioner that his request for disclosure (as amended during the litigation) was sufficiently specific to shift to the agency the burden of claiming an exemption from the Act, and it rejected the government's claim that 35 U.S.C. (Supp. V) 122 (which requires applications for patents to be kept confidential), and Exemption 3 of the Act, 5 U.S.C. 552(b)(3), exempt unpublished decisions *in toto*. However, the court concluded that those provisions do exempt the portions of such decisions that contain "detailed information" and "salient knowledge" pertaining to patent applications (Pet. App. A, p. 10a), and it concluded that the record was not adequate to permit it to determine which documents constituted "final opinions" subject to disclosure. Accordingly, the court remanded the case "to the district court for determining which materials are exempt and which are non-exempt, and with directions to the Patent Office to excise those portions of the requested documents which would reveal confidential information * * *" (Pet. App. A, pp. 10a-11a).

Petitioner challenges this decision on several grounds, none of which has merit or warrants further judicial consideration.

1. Petitioner contends (Pet. 2) that the Freedom of Information Act entirely overrides the requirement in 35 U.S.C. (Supp. V) 122 that patent applications "be kept in confidence."[2] But the court of appeals correctly held that

---

[2]35 U.S.C. (Supp. V) 122 provides:

> Applications for patents shall be kept in confidence by the Patent and Trademark Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

35 U.S.C. (Supp. V) 122, which by its plain terms preserves the confidentiality of Patent Office documents insofar as they contain "information concerning" patent applications, is a statute that specifically exempts certain matters from disclosure within the meaning of Exemption 3 of the Freedom of Information Act, 5 U.S.C. 552(b)(3).[3] This decision is consistent with that of the only other circuit to consider this question,[4] and it does not warrant review by this Court.

2. Petitioner also contends (Pet. 17) that the Patent Office improperly destroyed docket cards that would have aided in locating the decisions requested by petitioner. The district court found that the docket cards, which record the events in the course of processing a patent application, are not collected "in any way that would serve a regular index function within the Patent Office" and do not constitute a "true index" (Pet. App. B, pp. 16a-17a). Since the docket cards were not within the scope of petitioner's request for "indices" of decisions, the court

---

[3]As the court of appeals correctly observed (Pet. App. A, p. 4a n. 3), disclosure remains barred by Exemption 3 as recently amended, by Pub. L. 94-409, 90 Stat. 1247, since the exemption as amended still applies, *inter alia*, to statutes that refer "to particular types of matters to be withheld." 5 U.S.C. 552(b)(3)(B). 35 U.S.C. (Supp. V) 122 does refer to "particular types of matters"—patent applications and "information concerning the same."

[4]In *Sears* v. *Gottschalk*, 502 F. 2d 122, certiorari denied, 425 U.S. 904, the Fourth Circuit held that 35 U.S.C. (Supp. V) 122 is an "Exemption 3 statute" that exempts abandoned patent applications from disclosure.

of appeals correctly rejected (Pet. App. A, pp. 3a-4a) petitioner's contention that the destruction of the cards constituted contempt of court.

3. Petitioner contends (Pet. 17-18) that the Patent Office must index not only post-1967 "final decisions" but also non-final agency decisions containing policy statements or interpretations. But the district court did not hold that the indexing requirement was inapplicable to statements of policy, staff manuals, or other materials. Instead, the court simply noted that because the issue of indexing such materials had not been raised before the earlier appeal and remand, it was not properly before the court (Pet. App. B, p. 22a). The court indicated, however, that after investigation it had found that there were no such materials not already available to the public (Pet. App. B, p. 23a). Petitioner has not shown this determination to be clearly erroneous, and his contention that the decisions below stand for the proposition that policy statements, staff manuals, and other like materials are not subject to an indexing requirement under the Act is insubstantial.

4. Petitioner reiterates (Pet. 3, 10-13, 18) the argument he made when this case previously was before this Court (see note 1, *supra*), *i.e.*, that review is required here because the trial judge sent his law clerk to the Patent Office during the course of this litigation to make a "physical inspection of certain items" (Pet. App. C, p. 29a). Although petitioner objects to the district court's characterization of the law clerk's visit as a "physical inspection" and instead calls it "*ex parte* consultations" (Pet 18), he has not demonstrated any way in which he was prejudiced by the law clerk's action. The district court expressly concluded that petitioner suffered no prejudice as a result of the physical inspection of the Patent Office (Pet. App. C, p. 29a), and the court of appeals correctly affirmed (Pet. App. A, p. 4a).

5. Finally, petitioner objects to the court of appeals' refusal to correct alleged "factual errors" in its opinion in this case. However, a review of petitioner's motion to correct factual errors (Pet. App. E, pp. 31a-33a) indicates that the "errors" alleged either were so immaterial as not to warrant correction,[5] or were merely arguments and inferences made by the court of appeals with which petitioner does not agree.[6]

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

WADE H. MCCREE, JR.,
Solicitor General.

NOVEMBER 1977.

---

[5]For example, petitioner contended (Pet. App. E, p. 31a) that the court of appeals erred in describing his contempt motions as grounded on a claim that both the docket cards and the file wrapper jackets had been destroyed, since he had not raised any issue regarding file wrappers.

[6]Petitioner objected (Pet. App. E, p. 31a) to the court of appeals' description of the Patent Office's destruction of old docket cards as "routine," and to its description of his motion to vacate as grounded on the district court's "informal inspection" at the Patent Office, rather than on "ex parte * * * communications" (Pet. App. E, p. 32a).

DOJ-1977-11